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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,610	11/24/2000	Mohamed Khaled Mohamed El Hatw		1640

7590

08/15/2003

Mohamed Khaled Mohamed El Hatw
52 Tayaran Street - Nasr City
Cairo,
EGYPT

EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 08/15/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,610

Applicant(s)

EL HATW, MOHAMED KHALED
MOHAMED

Examiner

Brian Szmaj

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Egypt on November 22, 1999. It is noted, however, that applicant has not filed a certified copy of the Egyptian application as required by 35 U.S.C. 119(b).

Claim Objections

2. Claims 2 and 3 are objected to because of the following informalities: The use of "The previously mentioned probe is" in line 1 of the claims should be removed.

Appropriate correction is required.

3. Claims 2 and 3 are objected to because of the following informalities: The use of "&" in line 10 in Claim 2 and in line 11 in Claim 3 should be replaced with "and".

Appropriate correction is required.

4. Claim 2 is objected to because of the following informalities: "an electrical source" in line 12 of the claim should read as "the electrical source is". Appropriate correction is required.

5. Claim 1 is objected to because of the following informalities: "an electrical source" in line 12 should read as "the electrical source is". Appropriate correction is required.

6. Claims 1-3 are objected to because of the following informalities: the phrase "that is" in line 1 of the claims should be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of multiple wires in the claims cause the claims to be indefinite because it is unclear if the wire is being used multiple times for creating an electrical circuit or if there are two separate wires for creating the electrical circuit to measure the impedance or resistance. Since one wire cannot be used to create a closed circuit the Examiner assumes that there are two separate wires. Furthermore, two separate wires are used in Figure 1.

Regarding Claim 1:

“a wire” in line 10 should read as “a first wire” to overcome the rejection.

“a wire” in line 17 should read as “ a second wire” to overcome the rejection.

Regarding Claim 2:

“a wire” in line 9 should read as “a first wire” to overcome the rejection.

“a wire” in line 17 should read as “ a second wire” to overcome the rejection.

Regarding Claim 3:

“a wire” in line 10 should read as “a first wire” to overcome the rejection.

“a wire” in line 13 should read as “ a second wire” to overcome the rejection.

"the other wire" in line 15 should read as "said first wire" to overcome the rejection.

9. Claim 1 recites the limitation "the electrical source" in line 11. There is insufficient antecedent basis for this limitation in the claim.

The phrase should be changed to "an electrical source" to overcome the rejection.

10. Claim 1-3 recite the limitation "the cutting grooved biopsy needle" in line 24 in Claim 1, in line 24 in Claim 2, and in line 18 in Claim 3. There is insufficient antecedent basis for this limitation in the claim.

The phrase should be changed to "a grooved biopsy needle" to overcome the rejection.

11. Claim 3 recites the limitation "the electrical impedance monitor" in line 12. There is insufficient antecedent basis for this limitation in the claim.

The phrase should be changed to "an electrical impedance monitor" to overcome the rejection.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by Stoianovici et al.

Stoianovici et al disclose a surgical needle probe for electrical impedance measurements and further disclose a sensor at the tip to detect the electrical impedance of the target tissue; a wire running inside the body of the probe with one of the terminals at the distal end of the probe and the other terminal connected to the impedance monitor; a wire connecting the impedance monitor to the body of the probe; and the probe is replaced by a biopsy instrument to obtain a biopsy of the target tissue. See Column 3, lines 1-63; and Column 6, lines 28-42.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papa in view of Urban et al.

Papa discloses the use of a diagnosing sensor device for detecting lesions in body tissues and further discloses a first wire inside the body of the probe connected to the electrical source; the electrical source is located at the handle of the probe or outside the probe; an ammeter; and a second wire connected to the electrical source and the other end terminating near the end of the first wire; and the tissue condition is monitored

Art Unit: 3736

by monitoring the electrical resistance of the tissue. See Column 2, lines 52-68; Column 3, lines 1-23; and Column 4, lines 8-10.

Papa however fails to disclose the use of a hollow metal cylindrical sheath for introducing the probe into the tissue.

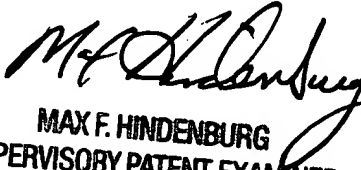
Urban et al disclose the use of a percutaneous introducer and further discloses the use of a hollow metal cylindrical sheath for introducing the probe into the tissue. See Column 7, lines 33-45; and Figures 9 and 12.

Since both Papa and Urban et al disclose means for affecting a biopsy, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Papa to include the use of a trocar, as per the teachings of Urban et al, since it is well known in the art to use a trocar or introducer sheath to access the target tissue when using some devices during a biopsy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj who's telephone number is (703) 308-3737 and the central fax number is (703) 872-9306. The examiner can normally be reached on Monday-Friday, with second Fridays off.

BS

August 5, 2003


MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700